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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,699	08/02/2001	Eric R. Alling	51108	9149
7590	04/07/2006		EXAMINER	
Dike, Bronstein, Roberts & Cushman Intellectual Property Practice Group EDWARDS & ANGELL P.O. Box 9169 Boston, MA 02209			DESHPANDE, KALYAN K	
			ART UNIT	PAPER NUMBER
			3623	
DATE MAILED: 04/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/837,699	ALLING, ERIC R.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kalyan K. Deshpande	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the ~~maximum~~ statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 January 2006.
- 2a) This action is FINAL.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 3,5,15,22 and 24 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 2, 4, 6-14, 16-21, 23, and 25-37 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 August 2001 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Introduction***

1. The following is a final office action in response to the communications received on January 26, 2006. Claims 1-32 are now pending in this application. Claims 1, 2, 4, 6-14, 16-21, 23, and 25-30 have been amended. Claims 3, 5, 15, 22, and 24 have been cancelled. Claims 33-37 are new claims.

### ***Response to Amendment***

2. Applicants' amendments to claims 1, 2, 4, 6-14, 16-21, 23, and 25-30 are acknowledged. New claims 33-37 are acknowledged. Examiner withdraws the 35 U.S.C. § 101 rejections. Examiner maintains the objection to the abstract for failing to conform to the word limit amount. Examiner also asserts an additional specification objection for failing to provide proper antecedent basis for claimed language.

### ***Response to Arguments***

3. Applicants' arguments filed January 26, 2006 have been fully considered but they are not found persuasive. Applicant argues i) Han fails to teach "providing access to an account maintained on behalf of said customer enterprise" and ii) Examiner's Official Notice of "receiving data inputs from a marketing enterprise" is improper.

Applicant argues that Han fails to teach "providing access to an account maintained on behalf of said customer enterprise". Specifically, Applicants argue that an assigned number usable by the customer to track customer requests is not account. Examiner respectfully disagrees. Han teaches a customer entering an assigned number at the applications main web page in order to retrieve specific information

regarding the customer's requests (see ¶¶ 90-93). Furthermore, the information retrieved by the application upon the customer entering the assigned number includes owner information (individual requesting information), assigned team to provide the owner with service, and the specific information that the owner is requesting (see ¶ 94 and figure 11). All of this information is specific to the customer and is tracked by the system for the benefit of the customer. Because all of this information is tied to a unique number assigned to a customer, it is the same as providing access to an account tracked on behalf of the customer.

Applicants further argue that Examiner's Official Notice of "receiving data inputs from a marketing enterprise" is improper. Examiner respectfully disagrees. Examiner notes the following discussion of Official Notice taken from the MPEP:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate. (MPEP § 2144.03(C))

Applicant has not "specifically point[ed] out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." Applicant's broad request for references to support Examiner's statements of Official Notice amounts to nothing more than an unsupported challenge. For these reasons, receiving input from a marketing enterprise for product development is taken to be admitted prior art because Applicant's traversal was inadequate. Furthermore, Examiner submits previously cited Bicknell et al. (U.S. Patent Publication No. 2003/0018511) as evidence to support that Official Notice was properly taken. Bicknell et al. teach the use of marketing information in the ideation of a new product (see ¶¶ 122 and 125, and figures 21 and 26).

### ***Specification***

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because the abstract exceeds 150 words. Correction is required. See MPEP § 608.01(b).

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification fails to include reference to "new trends in consumer behavior" and "economic or market conditions influencing said consumer behavior".

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 6-21, and 25-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Han et. al. (U.S. 2002/0052807).

As per claim 1, Han teaches:

A computer-implemented method for facilitating product development processes within a multi-enterprise environment via a

computer network, said multi-enterprise environment including a product development enterprise and at least one customer enterprise, comprising:

providing access to a web site of said product development enterprise by said at least one customer enterprise via said computer network (see ¶¶ 90; where a participant points his browser to the product design main web page);

providing access to an account maintained on behalf of said customer enterprise (see ¶¶ 94; where a customer initiates a request for a quote and the RFQ is assigned a specific number the customer uses to track the RFQ. Thus the RFQ acts as a customer account that the customer can maintain via the website.) ;

receiving data inputs pertaining to a product development request for a new product, said product development request originating from said customer enterprise (see ¶¶ 63 and 83; where a participant uses the product design application service in order to make modifications to the product definition. The modifications to existing product definitions results in the creation of a new product.);

storing said data inputs received from the customer enterprise and the marketing enterprise in a data storage device (see ¶¶ 84; where the requested modification replaces the subsisting product definition and the participant can store the modification request in any database maintained by the participant);

extracting said data inputs received from the customer enterprise and the marketing enterprise for review and analysis (see ¶¶ 88; where a rules engine evaluates the modification request and determines whether the combination of products is permissible); establishing a product development plan in response to said review and said analysis (see ¶¶ 87; where inter-product specification data is created showing what type of features will be needed for the combination of parts and plans how the final product should be authored); executing said product development plan (see figure 9(C)(2); where once the rules engine permits the combination of parts, the whole product is authored); wherein said product development enterprise is running a product specification and development application for implementing said product development processes (see ¶¶ 45 and 46; where the invention is described as a design-to-order development application and the product information utilized is in the form of product definition data).

As per claim 1, Han fails to teach:

wherein said inputs are provided by a marketing enterprise.

- new trends in consumer behavior;
- economic or market conditions influencing said consumer behavior;

competitor analysis ;

Han discloses a Team Participation Suite and an Enterprise Participation Suite, which create an interactive on-line environment where every member of the company's valued network can have participation with a product (see ¶¶ 60 and 61; Team Participation and Enterprise Participation Suites). Han describes the company's valued network as customers, internal departments, suppliers, partners, and channels. It is old and well known to one skilled in product development to include a marketing enterprise as one of the internal departments described by Han. The advantage of including a marketing enterprise would be to analyze and provide feedback for a customer facing application. A marketing enterprise could further provide competitor information, customer profiles, and the best methods to market the product. Examiner submits that at the time of the invention it would have been obvious to one of ordinary skill in product development to include a marketing enterprise as a member of the company's valued network in order to provide competitor information, customer profiles, the best methods to market, and to analyze and provide feedback for a customer facing application, thereby enhancing the quality of inputs received and improving the overall product development (see ¶¶ 12; where Han describes a goal of the application is to facilitate the design process to reach the right design that is cheapest for the manufacturer and best for the consumer). Additionally, Official notice is taken that it is old and well known in marketing for a marketing enterprise to provide information on new trends in consumer behavior, economic or market conditions influencing consumer behavior, and competitor analysis for the development of a product. Each of these factors gauge the

success rate for a product in any given market. At the time of the invention it would have been obvious to one of ordinary skill in product development to include a marketing enterprise's participation in the development of a product and to allow for the marketing enterprise to deliver data on new trends in consumer behavior, economic or market conditions influencing consumer behavior and competitor analysis in order to understand the chance of success of the developed product, thereby enhancing the quality of inputs received and improving the overall product development (see ¶¶ 12; where Han describes a goal of the application is to facilitate the design process to reach the right design that is cheapest for the manufacturer and best for the consumer).

As per claim 2, Han teaches:

The computer implemented method of claim 1, further comprising:  
receiving data inputs pertaining to said product development, wherein  
said inputs are provided by a research and development  
organization (see ¶¶ 64; where an engineering participation suite is  
included allowing engineering the ability to make new designs and  
manipulate the animation engine responsible for communicating  
product usage. Since engineering is creating new designs, they  
are doing research and development and are interpreted as a  
research organization).

As per claim 4, Han teaches:

The computer-implemented method of claim 2, wherein said inputs  
provided by said research and development organization include:

new process technology (see ¶¶ 64; where an engineering participation suite is included allowing engineering the ability to make new designs and the procedures to combine these new designs with existing ones);

new applications for existing properties of a product or product element (see ¶¶ 64; where an engineering participation suite is included allowing engineering the ability to make new designs and manipulate the animation engine responsible for communicating product usage)

As per claim 4, Han fails to disclose:

industry standards pertaining to a product or process.

Official notice is taken that it is old and well known in research and development to recognize the current industry standards and develop products or processes that provide some advantage over current industry offerings. Research and development organizations by virtue investigate the current industry standards to develop new technologies. For example, a research and development organization will research a technology by examining current patents and develop a new or improved technology different from existing technology. Examiner submits that at the time of the invention it would have been obvious to one of ordinary skill in research and development to provide the industry standards pertaining to a product or process in order to allow all internal departments to create a strategy to develop a new or improved product or process that has advantages to what is currently offered in the industry.

As per claim 6, Han discloses:

The computer-implemented method of claim 1, wherein said data inputs received from the customer enterprise include product specifications (see ¶¶ 83; where a participant uses the product design application service in order to make modifications to the product definition, where the product definition is the product specification)

As per claim 7, Han discloses:

The computer-implemented method of claim 1, wherein said data inputs received from the customer enterprise include product specifications changes (see ¶¶ 83; where a participant uses the product design application service in order to make modifications to the product definition).

As per claim 8, Han discloses:

The computer-implemented method of claim 1, wherein said data inputs received from the customer enterprise include process technology changes (see ¶¶ 83 and 87; where a participant uses the product design application service in order to make modifications to the product definition and these modifications change what type of features the product will have and the additional procedures necessary to incorporate these features).

As per claim 9, Han discloses:

The computer-implemented method of claim 2, wherein said data inputs are received from the customer enterprise, the marketing

enterprise, and the research and development organization at a plurality of points throughout a product development cycle (see ¶¶ 83 and 94; where a participant uses the product design application service in order to make modifications to the product definition at one point and where a customer can create and edit a request for quote for a needed service or product at another point)

As per claim 10, Han discloses:

The computer-implemented method of claim 1, wherein said extracting said data inputs received by the customer enterprise and the marketing enterprise occurs at a plurality of points throughout a product development cycle (see ¶¶ 87 and 94; where, based on the data extracted, inter-product specification data is created showing what type of features will be needed for the combination of parts and how the final product should be authored, and where a community participant can review the RFQ and define the players, assigned roles, and the interaction workflow).

As per claim 11, Han discloses:

The computer-implemented method of claim 1, wherein said extracting said data inputs received by the customer enterprise and the marketing enterprise for said review and analysis causes refinements to be made in said product development plan (see ¶¶ 87; where inter-product specification data is created showing what types of features will

be needed for the combination of parts and how the final product should be authored);

As per claim 12, Han discloses:

The computer-implemented method of claim 1, wherein said customer enterprise is a supplier (see ¶¶ 60, 95, and figure 3; where suppliers can be participants).

As per claim 13, Han discloses:

The computer-implemented method of claim 1, wherein said customer enterprise is a manufacturer (see figure 3; where manufacturers can be participants).

As per claim 14, Han teaches:

A system for facilitating product development processes within a multi-enterprise environment via a computer network, said multi-enterprise environment including:

a product development enterprise, comprising;

a server located on a host system (see figure 2B; where a server is located on a host system);

at least one terminal (see figure 2B; web clients are terminals used to access the server);

a data storage device (see figure 2B; where a storage device is listed); and

a network for allowing said host system, said at least one terminal and said data storage device to communicate (see figure 2B; where the server on the host system and the database are on an intranet allowing them to communicate and the web clients and host system can communicate via the internet);

at least one customer enterprise, comprising:

a server (see figure 2A; a server is present);

at least one terminal (see figure 2A; where web clients are terminals used to access the internet and servers);

a network for allowing said terminal and said server to communicate; and a communications network for allowing said at least one customer enterprise to communicate with said product development enterprise (see figure 2A; where the web clients and the server communicate via the internet, the server (the customer enterprise) and product development enterprise communicate via the internet);

Wherein said product development enterprise is executing a product specification and development application, the specification and development application performing (see ¶¶ 45 and 46; where the invention is described as a design-to-order development application and the product information utilized is in the form of product definition data):

Claim 14 further recites limitations already addressed by the rejection of claims 1, 2, 4, and 6-13; therefore the same rejections apply to this claim.

Claims 16-21, 23, 25-37 further recites limitations already addressed by the rejection of claims 1, 2, 4, and 6-14; therefore the same rejections apply to these claims.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalyan K. Deshpande whose telephone number is (571)272-5880. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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